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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,907	10/23/2003	Robert Galli	P00573-US2	6537

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EXAMINER

CHOI, JACOB Y

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,907

Applicant(s)

GALLI, ROBERT

Examiner

Jacob Y. Choi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 17-19 is/are allowed.
- 6) ☒ Claim(s) 5, 6, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 7-10 & 13-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 31, 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

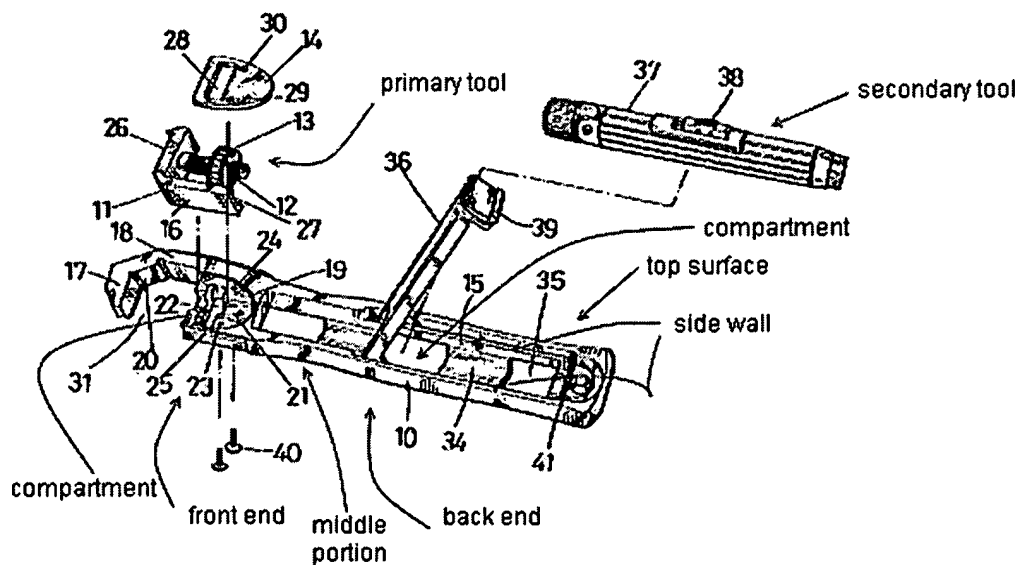
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **5, 6, 11 & 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (USPN 6,334,693).

Regarding claim 5, Lee discloses a housing (e.g., 10) having a primary compartment (e.g., 19), the primary compartment (e.g., 19) being configured to receive a primary tool (e.g., 11), the housing including a front end (e.g., 17), a back end (e.g., opposite end of the front) and a top surface (e.g., Figure 1), and a channel (e.g., 15) forming a secondary compartment (e.g., rear end/10) in the back end of the housing,

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the channel (e.g., 15) having a bottom wall (e.g., 34) and a side wall (e.g., near 15) extending upwardly between the bottom wall (e.g., 34) and the top surface with an opening in the side wall at the back end of the housing (e.g., 10), the channel (e.g., 15) slideably receiving and retaining a secondary tool (e.g., flash light) through the opening in the side wall (e.g., near 15) the channel (e.g., 15) including mating formation that engage and retain the secondary tool (e.g., column 2, lines 55-65; "... flashlight 37 therein, which may be easily and quickly engaged into the chamber 15 of the handle 10 ... the handle 10 and has a latch 39 provided on the other end thereof for engaging with a latch opening 41 of the handle 10 and for open-ably securing the cover 36 to the handle 10 and for securing the light device 37 in the handle 10 ... etc.").



Lee's drawing figures may not clearly distinguish what is the middle portion and back end of the outer casing/housing (e.g., labeled below).

It would have been obvious matter of design variation to change the size or scale of certain portion(s) of the outer casing/housing (e.g., 10), since such a modification

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would have involved a mere change in the size of a component (e.g., to extend the middle portion in order to specifically distinguish the back end). A change of size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). In addition, It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the secondary compartment that is structurally possible by housing element of Lee, sine it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Note: Claims in a pending application should be given their broadest reasonable interpretation (e.g., "*the back end*"). *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification (e.g., "*the back end*"). *In re Mraz*, 173 USPQ 25 (CCPA 1972).

Regarding claim 6, Lee discloses a closure element (36) pivotably connected to the back end of the housing (10), the closure element (36) being pivotably from a first open position to a second closed position over the opening in the sidewall (e.g., near 15) wherein the closure element (36) in the closed position retains the secondary tool (flash light) in the channel (15).

Regarding claim 11, Lee discloses an outer casing (e.g., 10) for receiving and enclosing primary device (e.g., 11), the outer casing (e.g., 10) having a front end (e.g., 17), a back end (e.g., opposite end of the front) and a top surface (e.g., Figure 1), and a channel (e.g., 15) forming a secondary compartment (e.g., rear end/10) in the back end of the housing, the channel (e.g., 15) having a bottom wall (e.g., 34) and a side wall

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(e.g., near 15) extending upwardly between the bottom wall (e.g., 34) and the top surface (e.g., Figure 1) with an opening in the side wall (e.g., near 15) at the back end of the housing (e.g., 10), the channel (e.g., 15) to slideably receiving and retaining a secondary tool (flash light) through the opening in the side wall (e.g., near 15) the channel (e.g., 15) including mating formation that engage and retain the secondary tool (e.g., column 2, lines 55-65; "... *flashlight 37 therein, which may be easily and quickly engaged into the chamber 15 of the handle 10 ... the handle 10 and has a latch 39 provided on the other end thereof for engaging with a latch opening 41 of the handle 10 and for open-ably securing the cover 36 to the handle 10 and for securing the light device 37 in the handle 10 ... etc.*").

Lee's drawing figures may not clearly distinguish what is the middle portion and back end of the outer casing/housing (e.g., labeled below).

It would have been obvious matter of design variation to change the size or scale of certain portion(s) of the outer casing/housing (e.g., 10), since such a modification would have involved a mere change in the size of a component (e.g., middle portion to be bit longer to distinguish the back end). A change of size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). In addition, It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the secondary compartment that is structurally possible by housing element of Lee, sine it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claim 12, Lee discloses a closure element (36) pivotably connected to the back end of the housing (10), the closure element (36) being pivotably from a first open position to a second closed position over the opening in the sidewall wherein the closure element (36) in the closed position retains the secondary tool (flash light) in the channel.

Response to Amendment

4. The examiner acknowledges that the applicant has amended claims 5 and 11. Claims 1-4, 6-10 & 12-19 remain unchanged, accordingly, claims 1-19 are pending in the application.

Response to Arguments

5. Applicant's arguments, see pages 7-10, filed January 31, 2006, with respect to the rejection(s) of claim(s) 5 and 11 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Lee (USPN 6,334,693).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*the secondary tool compartment be provided at the back end ... etc.*" and "*provides mating formations within the channel that engage and retain the secondary tool ... etc.*") –

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a. It would have been obvious matter of design variation to change the size or scale of certain portion(s) of the outer casing/housing (e.g., 10), since such a modification would have involved a mere change in the size of a component (e.g., to extend the middle portion in order to specifically distinguish the back end). A change of size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). In addition, It would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the secondary compartment that is structurally possible by housing element of Lee, sine it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

b. Column 2 lines 55-65 of Lee reference teaches "... *flashlight 37 therein, which may be easily and quickly engaged into the chamber 15 of the handle 10 ... the handle 10 and has a latch 39 provided on the other end thereof for engaging with a latch opening 41 of the handle 10 and for open-ably securing the cover 36 to the handle 10 and for securing the light device 37 in the handle 10 ... etc.*".

Allowable Subject Matter

6. Claims **7-10 and 13-16** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Claim 1 recites "*A housing having a channel configured within the top surface and extending inwardly from a peripheral edge of the back end of the housing, the channel having a bottom wall and opposing side walls extending upwardly from the bottom wall, and further having an opening in the side wall at the back end of the housing, the channel being configured to slideably receive a removable tool, the channel and the removable tool having complementary formations for interfitting engagement thereof, and a closure element movably coupled to the back end of the housing.*"

Claim 17 recites "*.... a secondary compartment having a front end, a back end, a top surface, and a channel configured within the top surface, the secondary compartment being configured to slideably receive the pocket knife in interfitting mated relation therein & the secondary compartment and the pocket knife having complementary formations for interfitting engagement thereof ... etc*"

Lee (USPN 6,334,693) teaches wrench / casing having channels & a closure element for a portable flashlight.

Because none of the reference cited discloses the combination of a case / housing assembly having both primary compartment and a secondary compartment / channel where secondary compartment / channel is configured to slideably receive the pocket-knife / removable tool in interfitting mated relation & the casing comprising a closure element removably coupled to *the back end* of the housing proving an open and

close operation, nor is there any motivation to combine them, the claims are deemed patentable over the prior art of record.

8. Claims **1-4 and 17-19** are allowed.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y. Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


ALI ALAVI
PRIMARY EXAMINER

JC